

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

The specification and claims have been amended in response to issues raised in the Office Action. Non-elected claims 12-20 and claims 3-5 and 10 were canceled without prejudice or disclaimer. New claims 21-33 have been added. Claims 1, 2, 6-9, 11 and 21-33 are currently pending in this application.

Support for the amendment to claim 1 and new claims 21-33 is provided in the following Table:

TABLE

Claim	Specification
1	Paragraph [0038]
21	Paragraph [0038]
22	Paragraph [0042]
23	Paragraph [0042]
24	Paragraph [0043]
25	Paragraph [0043]
26	Paragraph [0043]
27	Paragraph [0043]
28	Paragraph [0043]
29	Paragraph [0058]
30	Paragraph [0058]
31	Paragraph [0008], [0009]
32	Paragraph [0043]
33	Paragraph [0059]

Turning to the Office Action, Applicants affirm their election of Group I, claims 1-11, without traverse, in response to a telephone restriction requirement made by Examiner Dote. The non-elected claims have now been canceled.

The specification has been objected to for the reasons set forth in paragraph (5) on page 4 of the Office Action. Reconsideration of the objections is respectfully requested in view of the above amendments and the following remarks.

Reference to Patent Documents 1-5 in paragraphs [0003] and [0005] of the specification has been deleted. Patent Documents 1-5 were submitted in the Information Disclosure Statement filed November 14, 2003.

The specification has been amended in paragraph [0025] to correctly identify photosensitive member 10 in Figure 2.

Concerning item (3) in paragraph (5) of the Office Action, the specification has been amended to delete reference to comparative examples A7 through A10 and B7 through B10.

Accordingly, all objections to the specification have been obviated by the present amendments. In view thereof, the objection should be withdrawn.

Claims 3-5 were rejected under 35 U.S.C. §112, second paragraph, for the reasons given in paragraph (9) of the Office Action. Since these claims have been canceled, the rejection is moot.

Claims 1-11 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,603,535 to Tsutsui et al. combined with U.S. Patent No. 6,338,929 to Hagi et al. The Examiner's rationale is provided in paragraph (13) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested in view of the above amendments and for at least the following reasons.

Tsutsui et al. '535 discloses in column 17, lines 1-5 that post-treating agents "such as a fluidizing agent etc." can be added to toner particles. In column 9, lines 46-49, the reference states that "various organic/inorganic fine particles as fluidity-adjusting agent" can be added to the toners before a surface-modifying process and/or after a toner-particle preparation. A lengthy list of organic/inorganic compounds follows (column 9, line 49 to column 10, line 17). The list includes various metallic stearates. In the working examples of Tsutsui et al. '535, no toners are disclosed containing metallic stearates. It appears that only inorganic oxides are used in the examples as fluidity-adjusting agent.

Accordingly, there is no disclosure in Tsutsui et al. '535 which would motivate those skilled in the art to select metallic stearates as opposed to any of the other fluidity-adjusting agent disclosed therein. Further, Tsutsui et al. '535 does not disclose or suggest toners containing an externally added fatty acid metal salt in an amount of 0.005 to 0.015% by weight as specified in amended claim 1 and new claim 31.

Hagi et al. '929 discloses toners containing metal salts of fatty acids in amounts of 0.02 – 0.25 wt.% (column 6, line 37). When amounts of less than 0.02% are used, the desired lubricating function is not achieved.

Even if one were motivated to combine the disclosures of Tsutsui et al. '535 and Hagi et al. '929 as alleged in the Office Action, the resultant toners would still contain a metal salt of a fatty acid in amounts outside the range set forth in the present claims. Clearly, Hagi et al. '929 teaches away from using less than 0.02 wt.% of fatty acid metal salt.

For at least the above reasons, the §103(a) rejection based on Tsutsui et al. '535 combined with Hagi et al. '929 is inapplicable to the present claims and should be withdrawn. Such action is earnestly requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: February 23, 2005

By: _____


George F. Lesmes
Registration No. 19,995

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620